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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/767,283	01/22/2001	Gary D. Glick	128019-203802	2710

7590 09/21/2005

Medlen & Carroll, LLP  
David A. Casimir Esq  
101 Howard Street  
Suite 350  
San Francisco, CA 94105

EXAMINER
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KIM, VICKIE Y

ART UNIT	PAPER NUMBER
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1618

DATE MAILED: 09/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/767,283	<b>Applicant(s)</b> GLICK ET AL.	
	<b>Examiner</b> Vickie Kim	<b>Art Unit</b> 1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 130-137 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 130-137 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3&amp;5/01; 3/02; 4&amp;9/05</u> | 6) <input type="checkbox"/> Other: ____  |

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## **DETAILED ACTION**

### ***Status of Application***

Acknowledgement is made of preliminary amendment filed 01/22/01. Claims 1-129 are canceled. New claims 130-137 are added.

The claims 130-137 are pending and have been examined.

### ***Information Disclosure Statement(IDS)***

The information disclosure statement (IDS) is submitted on 3/19/2001; 5/21/2001; 3/25/2002; 4/6/2005; and 9/6/2005. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner. Please refer to applicants' copy of the 1449 submitted herewith.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of 35 U.S.C. 102 which forms the basis for all anticipatory rejections set forth in this Office action:

- (a)
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 130-137 are rejected under 35 U.S.C. 102(a) as being anticipated by Kim et al(1998, Synthesis of 3-substituted...)

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The claims are drawn to a compound having the structure as claimed in claim 1. Claim 135 is specifically drawn to a compound having a structure as shown in claim 35(=Bz-432). Claim 137 is drawn to a pharmaceutical composition using said compound.

Kim et al teach a 3-substituted 1,4-Benzodiazepin-2-ones such as a compound 1 at page 375. The compound 1 of Kim et al is same compound required by claim 135.

Since the said compound 1 of Kim et al is a specie that is encompassed by the generic formula required claim 130-134. Thus, all the limitations required by the claims 130-134 are well anticipated by the cited reference.

As to claim 137, at abstract, Kim et al teach that the preparation has been formulated for animal study. Thus, one would have been envisioned the pharmaceutical composition using the said compound 1 suitable for carrying out the administration to animal.

Thus, all the critical elements required by claim 130 and its dependent claims are well taught and the claim is anticipated.

### ***Conclusion***

1. No claim is allowed.
2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickie Kim whose telephone number is 571-272-0579. The examiner can normally be reached on Tuesday-Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Low be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**VICKIE KIM**  
**PRIMARY EXAMINER**

Vickie Kim  
September 19, 2005  
Art unit 1614